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10/622,146	07/16/2003	Tom McCarthy	03-637	1889
20306 7590 03/25/2008 MCDONNELL BOEHNNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
SHEER, CRISTINA O				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/622,146

**Applicant(s)**

MCCARTHY ET AL.

**Examiner**

CRISTINA OWEN SHERR

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 and 46-83 is/are pending in the application.
- 4a) Of the above claim(s) 14-36 and 46-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 37-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date July 11, 2007, February 27, 2006, and August 8, 2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



#### **DETAILED ACTION**

1. This communication is in response to applicant's amendment filed December 5, 2007. Claims 1-44 and 46-83 are currently pending in this case. Claim 45 is absent from the listing of the claims. Claims 1-13 and 37-44 are under examination.

#### ***Election/Restrictions***

2. Claims 14-36 and 46-83 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 5, 2007.

#### ***Information Disclosure Statement***

3. The information disclosure statements (IDS) submitted on July 11, 2007, February 27, 2006, and August 8, 2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

#### ***Claim Objections***

4. The claims are objected to because of the following informalities: claim 45 is missing from the numbering. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 11-13, 37, and 40-44 are rejected under 35 U.S.C. 102(b) as being anticipates by Hendricks et al (US 5,659,250).

7. Regarding claims 1 and 41 –

Hendricks discloses a system for rendering media content (e.g. abs) comprising:  
a first platform for storing media content, wherein the media content comprises an unrenderable state when received by the first platform (e.g. fig 3, 220);  
a second platform communicatively coupled with the first platform for rendering the stored media content (e.g. fig 3, 222);  
the first and second platforms cooperatively providing an interface for purchasing a right to render the stored media content at least one time (e.g. fig 3, 900); and  
at least one of the first platform and the second platform being operable to convert the stored media content to a renderable state upon the purchase of the right to render.  
(e.g. col 10 ln 57-67).

8. It is inherent that the compression, encryption, combining, multiplexing, etc of signals in Hendricks (e.g. col 6 ln 1-25) constitute making a signal unrenderable.

9. Regarding claim 2 –

Hendricks discloses the system of claim 1 further comprising: a distribution server connected to at least one of the first and second platforms and to at least one content source, the distribution server being operable to receive requests for content and to responsively retrieve content from the content sources (e.g. col 11 ln 20-45).

10. Regarding claim 3 –

Hendricks discloses the system of claim 1 further comprising: a distribution server connected to at least one of the first and second platforms and to at least one Content source (e.g. fig 2, 212), the distribution server being operable to track the usage of the content. (e.g. col 11 ln 47-55).

11. Regarding claim 4 –

Hendricks discloses the system of claim 1 further comprising: a distribution server connected to at least one of the first and second platforms and to at least one content source, the distribution server being operable to track the payment of the content. (e.g. col 11 ln 47-55).

12. Regarding claim 5 –

Hendricks discloses the system of claim 1 further comprising: distribution server connected to at least one of the first and second platforms and to at least one content source, the distribution server being operable to track the commerce of the content. (e.g. col 11 ln 47-55).

13. Regarding claim 6 –

Hendricks discloses the system of claim 1, wherein the first platform comprises a digital video recorder device that includes a storage device for storing the media content. (e.g. col 10 ln 57-67).

14. Regarding claim 11 –

Hendricks discloses the system of claim 1, wherein the unrenderable state comprises a first level of encryption that protects the media content from unauthorized rendering. (e.g. col 11 ln 20-45).

15. Regarding claim 12 –

Hendricks discloses the system of claim 11, wherein the media content is contained in a broadcast signal and the unrenderable state comprises a second level of encryption that protects the media content from unauthorized reception and storage. (e.g. col 9 ln 18-40).

16. Regarding claims 13, 42, 43, and 44 –

Hendricks discloses the system of claim 12, wherein the broadcast is one of an over-the-air broadcast, a cable broadcast, an Internet broadcast and a satellite broadcast, and receiver therefor (e.g. col 1 ln 28-32).

17. Regarding claim 37 –

Hendricks discloses the system of claim 1, wherein the media content is stored on the first platform in a compressed format. (e.g. col 11 ln 20-45).

18. Regarding claim 40 –

Hendricks discloses the system of claim 1, wherein the first platform comprises:

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a digital video recorder having a storage device for retaining, at least a portion, of the media content; (e.g. col 11 ln 20-45).

a personal computer operatively coupled with the digital video recorder, wherein the personal computer provides (e.g. col 13 ln 37-46) for:

the purchase of the right to render the media content; management of rendering of the media content including:

enforcing digital rights associated with the media content; and

controlling rendering of the media content in correspondence with terms of the purchase. (e.g. col 15 ln 20-50)

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 7-10 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks. Hendricks discloses as discussed above.

21. Regarding claim 7 –

Hendricks does not directly disclose a storage device specifically comprising a hard disk. Official Notice is taken having a storage device comprising a hard disk drive is old and well-known. Thus it would have been obvious to one of ordinary skill in the art to



combine Hendricks with such a storage device given how common, economical, easy to find and use such hard disk drives are.

22. Regarding claim 8 –

Hendricks discloses as discussed above but Hendricks does not specifically disclose wherein the first platform comprises a personal computer that includes a storage device for storing the media content. However, Official Notice is taken that the functions of a set top terminal are functions that old and well known to be performed by a personal computer. Thus, it would be obvious to one of ordinary skill in the art at the time the invention was made to have a personal computer act as set-top terminal since this would make integral in one unit which might otherwise be done in two devices. Moreover, the resulting combination is predictable and would allow for recording of content on the computer.

23. Regarding claims 9-10 –

Hendricks does not specifically disclose the limitations of claims 9 and 10. However, Official Notice is taken that a storage device comprising an optical storage device, such as a digital versatile disk (DVD) drive is old and well-known. Thus it would have been obvious to one of ordinary skill in the art to combine Hendricks with such a storage device given how common, economical, easy to find and use such DVD's are.

24. Regarding claims 38-39 –

Hendricks does not specifically disclose the various MPEG standards and layers thereof. However, Hendricks does contemplate using MPEG compressions standards generally. (e.g. col 6 ln 44-54, col 8 ln 23-38, col 9 ln 35-45, col 13 ln 56-61, col 14 ln

48-65). It would be obvious to one of ordinary skill in the art at the time the invention was made to include various MPEG standards and layers thereof for the compressed format.

25. Claims 1-6, 11-13, 37, and 40-44 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al (US 5,659,250).<sup>1</sup> It is the Examiner's principle position that the claims are anticipated because of the inherencies noted above in Hendricks.

26. However, if not inherent it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the compression, encryption, combining, multiplexing, etc of signals in Hendricks (e.g. col 6 ln 1-25) to constitute make a signal unrenderable. In other words, these are all methods of making a signal unrenderable or unreadable. Thus, even though Hendricks never uses the word "unrenderable", it is obvious that are ways of making of making a signal unrenderable or unreadable. Motivation for this would be the desire to make the system secure, thus preventing theft of the programs.

27. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

29. "Computers and How They Work", by Roderick Hames, Copyright© 1998, Alton C. Crews Middle School: CS Dept – Articles  
<http://www.crews.org/curriculum/ex/compSCI/articles/howcomput.htm>).

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA OWEN SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571)272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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<sup>1</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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